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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/688,582 | 10/17/2003 | Rajesh Kumar | 08688-056001 / UML 02-16, | 2269 |
| 26161 | 7590 | 11/05/2004 | EXAMINER MOORE, MARGARET G | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,582

Applicant(s)

KUMAR ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 to 9, 12 to 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 to 9, 12 to 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/13/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The disclosure is objected to because of the following informalities: Schemes 1, 2 and 3, which attempt to show the reaction process used to prepare the polyorganosilicones, are chemically inaccurate. Since there are two R' groups in the reactant, there must be two residual groups corresponding to the R' groups in the product. The divalent -A- group corresponds to the residue of one R' group. When n is greater than 1 there should be another on the right hand side of the -B-(C=O)- group. As shown, the -B-(C=O)- group is attached directly to the "x" repeating alkylene group. This is not correct. Also it does not appear that R or R' can ever be H, alkyl or aryl since such a polymer would not contain a reactive terminal group. In addition, the reaction shown on page 18 of the specification does not show the same siloxane reactant or product as that found in Schemes 1-3.

Appropriate correction is required.

2. Claims 7 to 9 and 12 to 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to teach the reactants or process necessary to make the claimed silicone. Note the paragraph supra which demonstrates the flaws in the specification. It is unclear what reaction occurs to form the silicone claimed. In addition there is nothing in the specification to indicate what monomers must be used in the process of claim 12 to arrive at the silicone. The only example provided in the specification does not correspond to the claimed silicone.

In addition, the specification fails to enable making a silicone having the elected species groups. Applicants' elected species includes an OH R group, an alkoxy R' group and NH as A. The specification certainly does not enable the selection of the particular reactants necessary to make such a polymer, that is, one having two different terminal groups and a divalent A group that is not the residue of either reactants' terminal group. Comparing this compound to the that in Scheme 1, applicants do not enable

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a process in which terminal OH groups (applicants' elected species) in one reactant react with alkoxy R' groups in another reactant to form the divalent -NH- A group.

3. Claims 24 to 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The new matter rejection applies to these claims, as they reflect the elected species. Applicants attempt to limit the chemical composition, which is generically disclosed, to a subgenus there under without an original teaching of the subgenus. Not having been specifically named or mentioned in any manner, one is left to selection from the myriad of possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made rather than any of the many others which could also be made. Such a selection amounts to a lack of written description for these claims. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. As noted supra, one cannot immediately envisage the product claimed from the disclosed process since it does not appear that such a product can be prepared from the process. Note MPEP 2163.05 (II) which supports this new matter assessment by indicating that a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species. The specification does not reasonably lead one skilled in the art to select the particular species combination as claimed.

4. Claims 7 to 9 and 12 to 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The requirement that B be aryl, alkyl or alkoxy is confusing since these are

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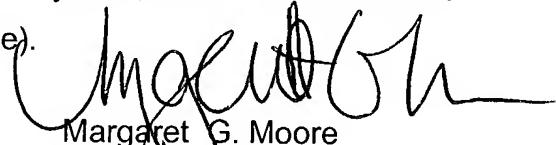
monovalent groups and B is divalent.

5. The elected species is neither taught nor suggested by the prior art. 5,070,169 teach siloxane copolymers but anticipate or render obvious the selection of each particular species requirement. The claimed species is not allowable, however, in view of the numerous rejections under 35 USC 112, noted above. 5,631,343, 6,288,129, 6,617,441, 6,486,295, 6,677,427 and 6,670,438 are cited as being of general interest, as teaching various reactions that are catalyzed by an enzyme.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
11/3/04